

Application/Control Number: 10/751,243
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/751,243
Filing Date: January 02, 2004
Appellant(s): MARIN ET AL.

Tenley Kruger
For Appellant

SECOND SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the appeal brief filed January 30, 2007 appealing from the Office action mailed August 30, 2007. This Supplemental Answer is intended to replace the Answers of 4/30/2002, 11/2/2007, and 7/18/2008; to address the Panel Remand of 6/19/2008; and to clarify the issues of the Appeal Brief of 1/30/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on October 30, 2006 has not been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct except that paragraphs 9 and 10 are disclosed on pages 6-7 of the Specification rather than the indicated pages 4-5.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

- (A) Claims 1, 3, and 10-12 under 35 U.S.C. 102(b) as being anticipated by Kaufmann et al. (US 5,770,752), and
- (B) Claims 1, 3, and 10-11 under 35 U.S.C. 102(b) as being anticipated by Schertl et al. (US 5,668,230).

(7) Claims Appendix

The copy of the appealed claims contained in **Appendix A** to the brief is correct.

(8) Evidence Relied Upon

5,770,752	Kaufmann et al.	6-1988
5,668,230	Schertl et al.	9-1997
5,807,800	Shamshoum et al.	9-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

- (A) Claims 1, 3, and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaufmann et al. (US 5,770,752).

1,1,2,2-tetraethylsilanediyl[2-methylindenyl(4-phenylfluorenyl)]zirconium dichloride of Kaufmann (col. 9, lines 16-17 and col. 13, lines 48-49) meets the limitation of the instant claims.

- (B) Claims 1, 3, and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Schertl et al. (US 5,668,230).

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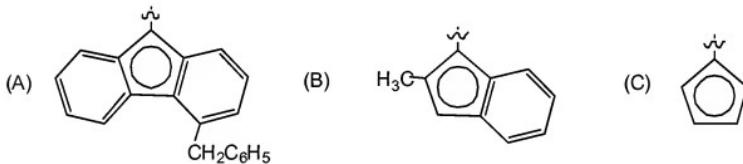
1,2-bis(4-benzyl-fluorenyl)ethane ZrCl₂ of Schertl (col. 6, Table 1) meets the limitation of the instant claims.

(10) Response to Argument

The rejection of claim 12 under 35 U.S.C. 102(b) over Schertl et al. (US 5,668,230) is withdrawn in view of appellants arguments since benzyl group is not a substituted phenyl group.

Appellants argue that both fluorenyl and indenyl groups are not substituted cyclopentadienyl groups.

4-benzyl-fluorenyl, 2-methylindenyl and cyclopentadienyl groups are represented by structures (A), (B) and (C) respectively as shown below:



Apparently, both structures (A) and (B) contain cyclopentadienyl group (C) and the rest of structures attached to the cyclopentadienyl groups in (A) and (B) are considered as the substituents. As a matter of fact, the fluorenyl and indenyl groups are often exemplified as substituted cyclopentadienyl, and such are demonstrated in Shamshoum et al. (US 5,807,800) cited by the Appellants in the IDS filed July 22, 2005, see lines 47-60 of col. 8, and lines 3-37 of col. 10 where the substituted cyclopentadienyl group CpR_n and CpR'_m of formula (12) in line 57 of col. 8 are exemplified as fluorenyl and indenyl in at least lines 14-22 of col. 10.

In view of the foregoing, the rejections are deemed to be proper and thus maintained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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